

## REMARKS

*Please note that the claim amendments provided above consist solely of further limiting the scope of claimed elements consistent with the specification in claims 1, 2, 23, 25, 29 and 30, and of correcting typographical errors identified in claims 20 and 21. These amendments are fully supported by the existing specification and do not result in the introduction of new matter to the specification. Consequently, as no new matter has been added, no new search is required.*

This application is believed to be in condition for allowance because the claims, as amended, are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasoning for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject patent application.

### **1.0 Rejections Under 35 U.S.C. §103(a):**

In the Office Action of September 3, 2003, claims 1-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hachamovitch et al., U.S. Patent 6,377,965 (hereinafter "**Hach**") further in view of Creswell et al., U.S. Patent 6,564,264 (hereinafter "**Creswell**").

In order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations.***

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), all of the claimed elements of an Applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

### 1.1 Rejection of Claims 1-22:

In general, the Office Action rejected independent claim 1 under 35 U.S.C. §103(a) based on the rationale that **Hach** discloses the Applicants' invention substantially as claimed, but that "Hach does not explicitly teach the limitation of 'dynamically tracking the data store'." The Office Action offers Figs. 1-7 and col. 6-15 of the **Hach** reference in support of this contention. The Office Action then suggests that **Creswell** discloses automatically updating a database based on incoming and outgoing mail messages. The Office Action offers Figs. 1-3 and col. 3-4 of the **Creswell** reference in support of this contention. The Office Action then suggests that it would have been obvious to one skilled in the art to modify **Hach** by "dynamically tracking a data store (database) as taught by Creswell to update a contact list at a client computer."

In general, as described in the Abstract of the **Hach** reference, **Hach** describes a "word completion system" that allows a user to select automatically displayed "word completions" from one or more "suggestion lists." This "word completion system" is operable with a number of computer applications, including, for example, word processing applications, email programs, and spreadsheet applications (see col. 4, lines 22-28). As described by **Hach**, the suggestion lists from which the "word completions" are either created or manually updated via a user interface, or drawn from "other dynamic system parameters, such as the time, the registered user's name, the registered user's business address, a logged-in user's name, a list of recent applications

or documents, a most-recently-used (MRU) text buffer, an MRU e-mail address buffer, the computer's file directory, etc" (see col. 10, line 64 through col. 11 line 3).

However, as admitted by the Office Action, **Hach** "does not explicitly teach the limitation of 'dynamically tracking the data store'." Further, in view of this admission, and in view of the preceding discussion, it should be clear that while **Hach** is capable of providing "word completions" within a number of application types, the "suggestion lists" from which word completions are drawn are **not** dynamically populated by "**analyzing and extracting contact information from items within the data store**" said data store including "**word processor files, spreadsheet files, and presentation files**" as described and claimed by the Applicants. For example, the Applicants describe and claim a system and method that is not only capable of extracting contact information from sent and received email messages, but is **also capable** of automatically analyzing and extracting contact information from other electronic application files including word processor files such as Microsoft® Word files, presentation files such as Microsoft® PowerPoint® files, and spreadsheet files such as Microsoft® Excel files. In contrast, **Hach** provides no teaching or suggestion indicating that contact information can be extracted from an analysis of such electronic files.

In fact, as noted above, the word completion information available to the **Hach** scheme is limited to manually populated or updated completion lists, or to "other dynamic system parameters, such as the time, the registered user's name, the registered user's business address, a logged-in user's name, a list of recent applications or documents, a most-recently-used (MRU) text buffer, an MRU e-mail address buffer, the computer's file directory, etc" (see col. 10, line 64 through col. 11 line 3). Further, it should be noted that while **Hach** does suggest that a "list of recent applications or documents" or "computer file directories," etc., can be used for populating the completion lists, **Hach** is apparently describing the use of dynamic information associated with such files (date, time, author, etc.) rather than any sort of analysis of the actual contents of the documents for the purpose of identifying and extracting contact information from within such documents.

Similarly, as described by the Office Action, **Creswell** discloses automatically updating a database based on **incoming and outgoing mail messages**. While **Creswell** does monitor such messages dynamically for the purpose of updating address database, **Creswell** fails completely to disclose any capability to analyze electronic files other than contact databases and email messages for extracting contact information. In particular, **Creswell** does not disclose a capability to analyze and extract contact information from items within the data store which includes “**word processor files, spreadsheet files, and presentation files**” as described and claimed by the Applicants. In particular, **Creswell** offers no teaching or suggestion regarding a system or method for automatically analyzing and extracting contact information from electronic application files, such as for example, word processor files including Microsoft® Word documents, presentation files such as Microsoft® PowerPoint® files, and spreadsheet files such as Microsoft® Excel files. In fact, **Creswell** does not appear to suggest that contact information can be extracted from an analysis of electronic files other than email messages or contact databases.

Therefore, in view of the preceding discussion, the modification of **Hach** by adding the **Creswell** capability to dynamically update a database based on incoming and outgoing mail messages fails to disclose the Applicants claimed elements of “**dynamically tracking a data store of items comprising a plurality of electronic documents including one or more of word processor files, spreadsheet files, and presentation files**” and “**analyzing and extracting contact information from items within the data store**”.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claim 1, and thus of dependent claims 2-22 under 35 U.S.C. §103(a) over **Hach** further in view of **Creswell** in view of the non-obviousness of the above-cited language of claim 1, as amended.

## 1.2 Rejection of Claims 23-28:

The Office Action rejected independent claim 23 on the same basis as claim 1. In particular, the Office Action suggested that “[c]laims 23-32 do not teach or define any new limitations above claims 1-22 and therefore are rejected under similar reasons.”

However, in view of the discussion provided above in Section 1.1, it is clear that neither **Hach** nor **Creswell**, nor any possible combination thereof, provides any disclosure or teaching directed towards “**dynamically tracking a data store and analyzing and extracting contact information from items within the data store**, the items within the data store comprising a plurality of electronic documents including one or more of **word processor files, spreadsheet files, and presentation files**” (emphasis added) as described and claimed by the Applicants.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 23, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claim 23, and thus of dependent claims 24-28 under 35 U.S.C. §103(a) over **Hach** further in view of **Creswell** in view of the non-obviousness of the above-cited language of claim 23, as amended.

## 1.3 Rejection of Claims 29-32:

The Office Action rejected independent claim 29 on the same basis as claim 1. In particular, the Office Action suggested that “[c]laims 23-32 do not teach or define any new limitations above claims 1-22 and therefore are rejected under similar reasons.”

However, in view of the discussion provided above in Section 1.1, it is clear that neither **Hach** nor **Creswell**, nor any possible combination thereof, provides any disclosure or teaching directed towards “an extract module that **analyzes and extracts**

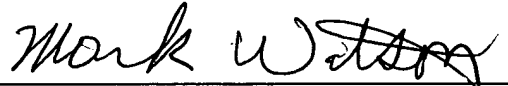
***contact information from items within a data store*** to dynamically track entries, said items within the data store comprising a plurality of electronic documents ***including one or more of word processor files, spreadsheet files, and presentation files***" (emphasis added) as described and claimed by the Applicants.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 29, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claim 29, and thus of dependent claims 30-32 under 35 U.S.C. §103(a) over ***Hach*** further in view of ***Creswell*** in view of the non-obviousness of the above-cited language of claim 29, as amended.

### CONCLUSION

In view of the above, it is respectfully submitted that claims 1-32, as amended are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-32 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark A. Watson", written over a horizontal line.

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